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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,886	06/07/2001	Toru Kuwahara	100809-16266 (SCET 18.734	7805
26304	7590	10/21/2004	EXAMINER	
KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK, NY 10022-2585			POND, ROBERT M	
			ART UNIT	PAPER NUMBER
			3625	
DATE MAILED: 10/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/876,886

Applicant(s)

KUWAHARA, TORU

Examiner

Robert M. Pond

Art Unit

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~ The MAILING DATE of this communication appears on the cover sheet with the correspondence address ~  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant amended Claims 8-10, and extensively amended Claim 9 due to missing claims elements as originally filed. All pending claims (1-10) were examined in this non-final Office Action.

### ***Response to Arguments***

#### **Rejection under 35 USC 103(a)**

Applicant's arguments, see Remarks, filed 30 July 2004, with respect to the rejection(s) of claim(s) 1-10 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as anticipated by Fredregill.

The previous Office Action combined Fredregill and Storey. In light of the Applicant's arguments and further review of Fredregill, the Examiner withdraws rejection under 35 USC 103(a) in favor of rejection under 35 USC 102(e). Fredregill discloses periods for specific commodities entitling the purchaser to bonus points (e.g. bonus start/stop dates). Fredregill further discloses bonus points being awarded in lieu of applying a general parameter.

*Pertaining to amended Claim 9*

Added claim elements mirror claims examined in the previous office action and therefore did not justify finality necessitated by amendment.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8 is claiming a computer apparatus but lacks the structural specificity necessary to execute the steps of the processing program as claimed. For examination purposes, the Examiner assumed the computer has at least a processor, memory, execution means to perform the execution steps.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-10 are rejected under 35 USC 102(e) as being anticipated by Fredregill et al. (Paper #2, patent number 5,923,016, hereinafter referred to as “Fredregill”).**

Fredregill teaches all the limitations of Claims 1-10. For example, Fredregill discloses a computer implemented consumer transaction point accumulation system means and method (see at least abstract; Fig. 1 (10, 12, 30, 40); col. 2, lines 18-57). Fredregill further discloses:

- Storing commodity information: stores name and price in master index using database storage means (see at least Fig. 1 (10); col. 11, lines 1-10). Please note examiner's interpretation: first storage means.
- Storing periods applied to specific commodities; parameters and relating periods: bonus points earned on specially promoted items (see at least col. 4, lines 23-25); defining start/stop date for specific item that maintains bonus point status (see at least col. 10, lines 3-5); storage means specific to commodity parameters (see at least Fig. 1 (30); col. 9, lines 56-62).

Please note examiner's interpretation: second storage means for start/stop date and third storage means for storing economic value.

- Storing a general-purpose parameter concerning economic return which is applied to commodities other than said specific commodities and to specific commodities for which periods to not include dates related to orders of the specific commodities: breakpoint parameter for sales transactions that generates regular points for commodities not exempt from regular or bonus points- not related to specific period; applying bonus points in lieu of applying a general parameter (see at least col. 4, lines 21-23, 56-59; col. 5 (Table 1)).
- Receiving a request for displaying information on commodities: POS display means for displaying requested commodity information (see at least Fig. 1 (12); col. 4, lines 25-27).
- Point generating means: (see at least col. 4, lines 15-20).
- Calculation means for first points: computer calculates regular points (see at least col. 4, lines 15-20).
- Calculation means for second points: computer calculates bonus points (see at least col. 4, lines 15-20).
- Calculation means base on eligible items: computer calculates exempt items (e.g. tobacco, alcohol) (see at least col. 4, lines 45-46).
- Software: software used to access host application; accessing the application controlling the system (see at least Fig. 1 (10; 30, 40); col. 7,

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lines 13-65). Inherent in the system and method of Fredregill is computer readable memory that stores program executed by a computer.

- Consumer identification and total points: stores customer account records and point balance (see at least col. 3, line 49 through col. 4, line 12).

Please note examiner's interpretation: fourth storage means.

Pertaining to system Claims 1-6

Rejection of Claims 1-6 is based on the same rationale as noted above.

Pertaining to computer and program code Claims 8 and 9

Rejection of Claims 8 and 9 is based on the same rationale as noted above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:


***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

703-872-9306 (Official communications; including After Final  
communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

  
Robert M. Pond  
Patent Examiner  
October 12, 2004